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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,617	01/30/2001	Jeffrey H. Banning	D/A0309I3I2D	8348

7590 09/17/2004

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/772,617

Applicant(s)

BANNING ET AL.

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 67-73 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-7 and 67-73 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 1-9 and 67-73 are currently pending in the instant application. Claims 8 and 9 are withdrawn from consideration as being for non-elected subject matter. Claims 1-7 and 67-73 are objected to as containing non-elected subject matter.

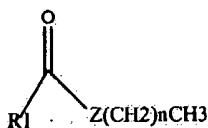
***Response to Arguments***

Applicant's arguments, see page 2 filed 14 August 2003 with respect to the 35 USC 112 2<sup>nd</sup> paragraph rejection of claims 6, 7, 68 and 69 have been fully considered and are persuasive. The rejection of claims 6, 7, 68 and 69 has therefore been withdrawn. The descriptive word "about", is not indefinite, but is term supported in the specification that is a clear but flexible term similar in meaning to terms such as "approximately" or "nearly".

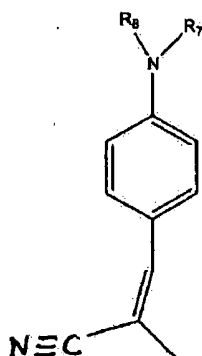
***Election/Restrictions***

Applicant's arguments, filed 14 August 2003 with respect to the objection to claims 1-7 and 67-73 as containing non-elected subject matter have been considered but are not persuasive. Applicant points out specific sections of the MPEP, specifically, 806.04(d), 809, 809.02(a), 809.02(c)(B), 809.04 and also points out 37 CFR 1.141(a). Applicant then argues that accordingly, the MPEP does not provide for requiring an Applicant to amend a generic claim to encompass only an elected species and that a complete examination of the generic claim of the instant application (claim 1). This argument is not found persuasive since the subject matter of claims 1-9 and 67-73 other than that of the elected invention for search and examination, the generic concept, i.e. other than compounds having the formula:

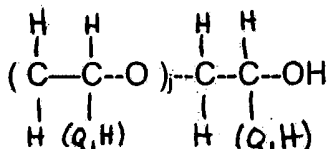
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Wherein Z is -NH-; n is 39; R1 is



Wherein the phenyl group may be substituted with substituents R50, R51, R52 and R53, as in claim 6, or the phenyl group may be unsubstituted as in claim 7; and R7 and R8 are hydrogen, alkyl, aryl, or



Wherein j is as defined, stand withdrawn under 37 CFR 1.142(b) as being for non elected subject matter, for reasons essentially those given in the last Office Action. Applicants' arguments of the objection to claims 1-7 and 67-73 have been considered but are not found persuasive. Applicants argue that the examiner has not examined the elected claims as required by MPEP 809 and has impermissibly withdrawn subject matter from claims 1-7 and 67-73. Applicants also argue that 37 CFR 1.141 does not authorize the examiner to withdraw from consideration certain subject matter from a claim.

Firstly, it is pointed out that the restriction requirement is made under 35 USC 121. 35 USC 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants argue to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. So, here we have claims, which involve more than one independent or distinct invention. Under 35 USC 121, the claims may be restricted and examination limited to a restricted invention. There is no argument or evidence to the contrary. Accordingly, restriction as has been presented in this application is proper and the objection to claims 1-7 and 67-73 is maintained.

#### ***Maintained Claim Objections***

Claims 1-7 and 67-73 are objected to as containing non-elected subject matter. Claims 1-7 and 67-73 drawn solely to the elected invention identified supra would appear allowable over the prior art of record.

#### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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9/17/04



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